

ESTTA Tracking number: **ESTTA484728**Filing date: **07/20/2012**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Vizio, Inc.
Granted to Date of previous extension	07/22/2012
Address	39 Tesla Irvine, CA 92618 UNITED STATES
Correspondence information	Rexford A. Johnson Parsons Behle & Latimer 960 Broadway, Suite 250 Boise, ID 83706 UNITED STATES trademarks@parsonsbehle.com Phone:2085624900

Applicant Information

Application No	85186781	Publication date	01/24/2012
Opposition Filing Date	07/20/2012	Opposition Period Ends	07/22/2012
Applicant	Vizio Medical Devices, LLC 200 Chambers Street, Suite 28A New York, NY 10007 UNITED STATES		

Goods/Services Affected by Opposition


Class 010. All goods and services in the class are opposed, namely: Ambulatory devices, namely, medical instruments for the removal of excess fluids; home devices for nocturnal removal of excess fluids, namely, medical instruments for the removal of excess bodily fluids; clinic-based, ambulatory, emergency care and nocturnal medical devices for removing toxins, namely, medical instruments for the removal of toxins from the bloodstream


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3235417	Application Date	03/29/2005
Registration Date	04/24/2007	Foreign Priority Date	NONE


Word Mark	VIZIO
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2004/03/31 First Use In Commerce: 2004/03/31 Televisions, Liquid Crystal Display Televisions, Plasma Televisions, Re-mote Control Units for Televisions Receivers, Television Monitors with or without Television Tuners, Television Accessories Namely, Component Cables and DVI-I Cables

U.S. Registration No.	4053025	Application Date	04/13/2011
Registration Date	11/08/2011	Foreign Priority Date	NONE
Word Mark	VIZIO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2004/03/31 First Use In Commerce: 2004/03/31 Liquid crystal display televisions; high definition DVD players; portable media players; portable media player docking stations; handheld computers; mobile phones; home theater systems comprising audio receivers and audio speakers; audio speakers; audio speakers in the nature of speaker bars; wireless routers; remote controls for televisions and audio equipment; stereoscopic lenses for 3D content viewing, namely, active 3D glasses, passive 3D glasses, and virtual reality glasses; high definition multimedia interface cables; stereo headphones		

U.S. Registration No.	3796179	Application Date	01/23/2008
Registration Date	06/01/2010	Foreign Priority Date	NONE
Word Mark	VIZIO TVP		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01 entertainment services, namely, on-going television and internet programs featuring award presentations recognizing superior performance by athletes		

U.S. Registration No.	3835959	Application Date	04/28/2009
Registration Date	08/17/2010	Foreign Priority Date	NONE
Word Mark	VIZIO INTERNET APPS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2009/12/31 First Use In Commerce: 2009/12/31 Televisions and monitors, namely, liquid crystal display televisions, plasma televisions, liquid crystal display monitors, and plasma monitors		

U.S. Application No.	85175965	Application Date	11/12/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	VIZIO ON DEMAND		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 009. First use: Liquid crystal display televisions; high definition DVD players; portable media players; portable media player docking stations; home theater systems comprising audio and video receivers, and audio speakers; audio speakers; audio speakers in the nature of speaker bars; wireless routers; remote controls for televisions and audio equipment; 3D television glasses; high definition multimedia interface cables; and stereo headphones
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U.S. Application No.	78811547	Application Date	02/09/2006
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	V VIZIO
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 009. First use: Speakers, namely, audio speakers and audio speakers in the nature of speaker bars; remote controls for compact disc players; televisions, liquid crystal display televisions, remote controls for televisions; television accessories, namely, component connecting electrical cables and DVI-I connecting cables; digital video disc players; personal digital assistants; MP3 players; portable and handheld digital electronic devices in the nature of computers for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, and audio files on portable and handheld digital electronic devices; headphones; portable and handheld devices for playing audio files in the nature of MP3 players; wireless devices for communications, namely telephones, telephone handsets, telephone headsets, audio speakers, and earphones; wireless enabled devices for communications, namely, telephones, telephone handsets, telephone headsets, audio speakers, and earphones
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U.S. Registration No.	3793660	Application Date	01/23/2008
Registration Date	05/25/2010	Foreign Priority Date	NONE

Word Mark	VIZIO TOP VALUE PERFORMER
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Design Mark	VIZIO TOP VALUE PERFORMER
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Description of Mark	NONE
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Goods/Services	Class 041. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01 Entertainment services, namely, on-going television and internet programs featuring award presentations recognizing superior performance by athletes
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Attachments	78978090#TMSN.jpeg (1 page)(bytes) 85294490#TMSN.jpeg (1 page)(bytes) 77378420#TMSN.jpeg (1 page)(bytes) 77724402#TMSN.jpeg (1 page)(bytes) 85175965#TMSN.jpeg (1 page)(bytes) 78811547#TMSN.jpeg (1 page)(bytes) 77378431#TMSN.gif (1 page)(bytes) 20020_143us82_Opposition to App for VIZIO RENAL by Vizio Medical Devices.pdf (7 pages)(22323 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Rexford A. Johnson/
Name	Rexford A. Johnson
Date	07/20/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Vizio, Inc.,)	Opposition No.: _____
)	
Opposer,)	Serial No.: 85/186,781
)	
v.)	Mark: VIZIO RENAL
)	
Vizio Medical Devices, LLC)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Commissioner of Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

Vizio, Inc., a California corporation, located and doing business at 39 Tesla, Irvine, CA 92618, (“Opposer”) believes that it will be damaged by registration of U.S. Trademark Application Serial No. 85/186,781 (“Application”) for the mark VIZIO RENAL owned by Vizio Medical Devices, LLC, a Delaware limited liability company, with offices at 200 Chambers Street, Suite 28A, New York, NY 10007, (“Applicant”) and therefore oppose the same.

As grounds for opposition, it is alleged:

1. By the Application filed on November 29, 2010, Applicant seeks to obtain registration on the Principle Register of the trademark VIZIO RENAL for “Ambulatory devices, namely, medical instruments for the removal of excess fluids; home devices for nocturnal removal of excess fluids, namely, medical instruments for the removal of excess bodily fluids; clinic-based, ambulatory, emergency care and nocturnal medical devices for removing toxins, namely, medical instruments for the removal of toxins from the bloodstream” in International Class 10.
2. Since at least 2004, long before the filing date of the Application, Opposer has been, and still is, engaged in the development, marketing, and sale of electronic devices, such as televisions, under the mark VIZIO and related marks.

3. Opposer owns and relies on U.S. Trademark Registration No. 3,235,417 (“the ‘417 Registration”) for the mark VIZIO for “Televisions, Liquid Crystal Display Televisions, Plasma Televisions, Re-mote Control Units for Televisions Receivers, Television Monitors with or without Television Tuners, Television Accessories Namely, Component Cables and DVI-I Cables” in International Class 9, which registration issued April 24, 2007 and is based on an application filed in the United States Patent and Trademark Office (“USPTO”) on March 29, 2005. The filing date of the ‘417 Registration is prior to the filing date of the Application.

4. Opposer owns and relies on U.S. Trademark Registration No. 4,053,025 (“the ‘025 Registration”) for the mark VIZIO for “Liquid crystal display televisions; high definition DVD players; portable media players; portable media player docking stations; handheld computers; mobile phones; home theater systems comprising audio receivers and audio speakers; audio speakers; audio speakers in the nature of speaker bars; wireless routers; remote controls for televisions and audio equipment; stereoscopic lenses for 3D content viewing, namely, active 3D glasses, passive 3D glasses, and virtual reality glasses; high definition multimedia interface cables; stereo headphones” in International Class 9, which registration issued November 8, 2011 and is based on an application filed in the USPTO on April 13, 2011.

5. Opposer owns and relies on U.S. Trademark Registration No. 3,796,179 (“the ‘179 Registration”) for the mark VIZIO TVP for “entertainment services, namely, on-going television and internet programs featuring award presentations recognizing superior performance by athletes” in International Class 41, which registration issued June 1, 2010 and is based on an application filed in the USPTO on January 23, 2008. The filing date of the ‘179 Registration is prior to the filing date of the Application.

6. Opposer owns and relies on U.S. Trademark Registration No. 3,793,660 (“the ‘660 Registration”) for the mark VIZIO TOP VALUE PERFORMER for “Entertainment services, namely, on-going television and internet programs featuring award presentations recognizing superior performance by athletes” in International Class 41, which registration issued on May 25, 2010 and is based on an application filed in the USPTO on January 23, 2008. The filing date of the ‘660 Registration is prior to the filing date of the Application.

7. Opposer owns and relies on U.S. Trademark Registration No. 3,835,959 (“the ‘959 Registration”) for the mark VIZIO INTERNET APPS for “Televisions and monitors, namely, liquid crystal display televisions, plasma televisions, liquid crystal display monitors, and

plasma monitors” in International Class 9, which registration issued August 17, 2010 and is based on an application filed in the USPTO on April 28, 2009. The filing date of the ‘959 Registration is prior to the filing date of the Application.

8. Opposer owns and relies on U.S. Trademark Application No. 85/175,965 (“the ‘965 Application”) for the mark VIZIO ON DEMAND for “Liquid crystal display televisions; high definition DVD players; portable media players; portable media player docking stations; home theater systems comprising audio and video receivers, and audio speakers; audio speakers; audio speakers in the nature of speaker bars; wireless routers; remote controls for televisions and audio equipment; 3D television glasses; high definition multimedia interface cables; and stereo headphones” in International Class 9, which was filed on November 12, 2010. The filing date of the ‘965 Application is prior to the filing date of the Application.

9. Opposer owns and relies on U.S. Trademark Application No. 78/811,547 (“the ‘547 Application”) for the mark V VIZIO for “Speakers, namely, audio speakers and audio speakers in the nature of speaker bars; remote controls for compact disc players; televisions, liquid crystal display televisions, remote controls for televisions; television accessories, namely, component connecting electrical cables and DVI-I connecting cables; digital video disc players; personal digital assistants; MP3 players; portable and handheld digital electronic devices in the nature of computers for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, and audio files on portable and handheld digital electronic devices; headphones; portable and handheld devices for playing audio files in the nature of MP3 players; wireless devices for communications, namely telephones, telephone handsets, telephone headsets, audio speakers, and earphones; wireless enabled devices for communications, namely, telephones, telephone handsets, telephone headsets, audio speakers, and earphones” in International Class 9, which was filed on February 9, 2006. The filing date of the ‘547 Application is prior to the filing date of the Application.

10. Opposer’s Registrations Nos. 3,235,417, 4,053,025, 3,796,179, 3,793,660, and 3,835,959 and Opposer’s Application Nos. 85/175,965 and 78/811,547 are valid, subsisting, unrevoked, and uncanceled; as such they constitute *prima facie* evidence of the validity of the registered and pending marks, and of Opposer’s ownership of the marks shown therein. Opposer’s registrations and applications also constitute notice to Applicant of Opposer’s claim of

ownership of the marks shown therein as provided in Sections 7(b), 22, and 33(a) of the Trademark Act.

11. Since at least before the filing date of the Application, Opposer has continuously used and promoted the above identified marks, collectively the “VIZIO marks”, in interstate commerce in connection with its goods. By virtue of Opposer’s continuous and substantial use, the VIZIO marks have become an identifier of Opposer and its goods, and distinguish Opposer’s goods from the goods of others. As a result, Opposer has built up, at great expense and effort, valuable goodwill in the VIZIO marks. Opposer has developed a significant amount of goodwill through the use and promotion of its VIZIO marks, such that consumers have come to recognize a family of “VIZIO” marks with which Opposer markets and sells its goods.

12. In addition to the protection afforded Opposer by its federal trademark registrations, Opposer has extensive common law rights in its VIZIO marks through the United States, having sold millions of dollars worth of goods under Opposer’s VIZIO marks. Opposer’s common law rights in its VIZIO marks predate the filing date of the Application. Opposer relies on its common law trademark rights in Opposer’s VIZIO marks.

13. Applicant seeks an unrestricted federal registration for VIZIO RENAL covering the goods set forth in the application in International Class 10. As such, if a registration issues for the Application, such registration will constitute *prima facie* evidence of the Applicant’s exclusive right to use the registered mark in commerce on or in connection with the listed goods throughout the United States with no limitation thereon.

14. Opposer will be damaged by registration of the Application in that the VIZIO RENAL mark so resembles Opposer’s VIZIO marks registered and pending in the USPTO, and in which Opposer owns common law trademark rights, as to be likely, when used on or in connection with the goods as they are identified in the Application, as to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

15. In view of Opposer’s prior rights in its VIZIO marks, Application is not entitled to federal registration of the VIZIO RENAL mark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer prays that U.S. Trademark Application Serial No. 85/186,781 be rejected and stricken, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Please charge Deposit Account No. 50-0581 to cover the opposition fee and any additional fees which may be required, or credit any overpayment to this account.

Respectfully submitted,
Parsons Behle & Latimer

Dated: /July 20, 2012/

By: /Rexford A. Johnson/

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Attorneys for Opposer,
Vizio, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant's attorney of record by depositing one copy thereof in the United States Mail, first-class postage prepaid, on July 20, 2012, addressed as follows:

TEDD W. VAN BUSKIRK
K&L GATES LLP
599 LEXINGTON AVE
NEW YORK, NY 10022-6030

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/Julie O'Tyson/
Julie O'Tyson